

**Notice of Allowability**

Application No.

09/916,485

Examiner

Taylor Victor Oh

Applicant(s)

GERBER ET AL.

Art Unit

1625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/30/04.
2. ☒ The allowed claim(s) is/are 1-8, 10-17, and 19-24, renumbered as claims 1-22.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                 |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date <u>1/24/05</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment   |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance                        |
|   | 9. <input type="checkbox"/> Other _____.  |

Examiner's Amendment and Reasons of Allowance

The Status of Claims

Claims 1-8, 10-17, and 19-24 are pending.

Claims 1-8, 10-17, and 19-24 have been allowed.

Claims 9 and 18 have been canceled.

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with an attorney of record, Mr. George F. Lesmes on 1/24/2005 .

I. The application has been amended as follows:

In claim 1, line 4 on page 2 (amendment dated on 12/30/04):

The term “ -- having --” before the phrase “ 5-20 carbon atoms ” has been replaced with “of ”.

In claim 1, line 5 on page 2 (amendment dated on 12/30/04):

The term “ -- having --” before the phrase “ 2-20 carbon atoms ” has been replaced with “of ”.

In claim 1, line 7 on page 2 (amendment dated on 12/30/04):

The phrase “ -- R<sub>3</sub> represents a cyclic aliphatic group --” before the comma has been replaced with “R<sub>3</sub> represents a cyclic aliphatic group of 6 to 7 carbon atoms ”.

In claim 1, line 8 on page 2 (amendment dated on 12/30/04):

The term “ -- containing --” before the phrase “ 2 to 10 carbon atoms” has been replaced with “ of ”.

In claim 1, line 11 on page 2 (amendment dated on 12/30/04):

The term “ -- containing --” before the phrase “ 2 to 10 carbon atoms” has been replaced with “ of ”.

In claim 10, line 5 on page 4 (amendment dated on 12/30/04):

The term “ -- contains --” before the phrase “ at least ” has been replaced with “ has ”.

In claim 22, line 5 on page 4 (amendment dated on 12/30/04):

The term “ -- contains --” before the phrase “ at least ” has been replaced with “ has ”.

Claim 9 has been canceled.

II. The following is an examiner's statement of reasons for allowance:

- The rejection of Claims 1-8 ,10-17, 19-24 under 35 USC 112, second paragraph, has been withdrawn due to the modification made in the amendment.
- The close reference for the current invention is Kawai et al (JP10330470).

Kawai et al discloses the fatty acid-modified polyester polyol composition is obtained by reacting an 8-30 carbon fatty acid and a phthalic anhydride with an ethylene glycol (see a front page of abstract). Furthermore, the reaction takes place at temperature of 200 to 230° C.

The instant invention, however, differs from the prior art in that the prior art compound does not disclose the cyclic aliphatic dicarboxylic acid or anhydride which is part of the claimed compounds ; the claimed method is a two-step process in which a half-ester of a hydroxy containing acid or ester and a cyclo-aliphatic dicarboxylic acid or anhydride is prepared initially and then reacted with a polyhydroxy compound in a subsequent step, whereas the prior art process is a one-step condensation by simultaneously reacting a fatty acid or ester a dicarboxylic acid and a polyol ; therefore, there is no motivation in the prior art by changing one-step-process into a two-step process. In addition, unless all limitations of the claims are met, there is no prior art rejection. See In re Zurko 59 USPQ 2d 1690 (Fed Cir. 1991) and In re Lee, 61 USPQ 1430 (Fed Cir. 1991).

Therefore, the claimed invention would not have been obvious to the person with an ordinary skill in the art because the skilled artisan in the art would not expect to arrive at the current invention by using the prior art's compounds and its method .

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning the communication after allowance such as sending all post-allowance correspondence should be directed to "Box Issue Fee" or faxed directly to PUBS at 703-305-8755. This will expedite the process of these papers.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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1/26/05*

*Cecilia Tsang*  
Cecilia J. Tsang  
Supervisory Patent Examiner  
Technology Center 1600